

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/523,380
Applicant(s): Robin J. Blackwell, et al.
Filed: February 1, 2005
TC/A.U.: 2100/2145
Examiner: Ryan J. Jakovac
Atty. Docket: GB 030054
Confirmation No.: 3721
Title: A NETWORK ESTABLISHMENT AND
MANAGEMENT PROTOCOL

PETITION TO THE GROUP DIRECTOR UNDER 37 C.F.R. § 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition the Group Director of Group 2400 for the requirement that Applicants provide either a terminal disclaimer or a traversal of a rejection for non-statutory double-patenting, and specifically seek relief that their offer to file a terminal disclaimer when all other rejections and objections are negated be considered fully responsive to the current double-patenting rejection.

I. Statement of Facts

A non-final rejection was mailed on June 25, 2008, and included a rejection under the non-statutory double-patenting rejection in view of US Patent Application

10/523,377. A response to this Office Action was filed on October 27, 2008, and included an offer to provide a terminal disclaimer at the stage of prosecution when the double-patenting rejection is the only remaining obstacle to issue. In particular, Applicants' response included:

Double Patenting Rejection

Applicants acknowledge the provisional double-patenting rejection under the judicially created doctrine of obviousness double-patenting. If necessary and proper, Applicants will provide a terminal disclaimer at a future date if such a rejection remains the only obstacle to allowance of the claims rejected hereunder.

A Notice of Incomplete Reply was mailed on December 8, 2008 indicating that the Response of October 27, 2008 was not fully responsive for failing to respond to the double-patenting rejection. The undersigned attorney contacted the Examiner on January 8, 2009 and had a telephonic interview with the Examiner to discuss Applicants' position. No agreement was reached. A concurrent response under Rule 111 is being filed. As the issue presented is not believed to be appealable, but rather petitionable, Applicants provide this petition.

2. Relief Sought

Applicants respectfully request that their offer to provide a terminal disclaimer be considered responsive to the rejection at this stage of prosecution for at least the following reasons. As is known, a terminal disclaimer may be filed under 37 C.F.R. § 1.321(b) to obviate a rejection for non-statutory obviousness-type Double-patenting. While the basis for this is clear, a prematurely filed terminal disclaimer can have an unintended prejudicial impact on the patentee.

For example, as in the present circumstance, the claims may not be currently held allowable over art in addition to the patent application applied in the non-statutory double-patenting rejection. Suppose further that a terminal disclaimer were filed at this point in prosecution in order to nullify the double-patenting rejection. If the claims are later amended to overcome additional art, the double-patenting rejection may also be

rendered moot by this amendment. In addition, or alternatively, the art that requires the amendment to the claims may not even be of record at the time of filing of the terminal disclaimer. Moreover, US Patent Application 10/523,377 may be abandoned, rendering the double-patenting rejection moot. Regardless, in either scenario, the terminal disclaimer is rendered supererogatory by the amendment to the claims. Yet, because the terminal disclaimer is already filed and cannot be withdrawn, the patentee will have divested rights in any patent that may mature from the present application. Thus, the terminal disclaimer's being prematurely filed compromises the patentee's rights when this terminal disclaimer may not be required after all.

By contrast, if Applicants are permitted to prosecute the application to the point that only the double-patenting rejection remains, a filing of the terminal disclaimer will render this rejection moot and the rights of the patentee will not be unnecessarily compromised. Finally, the timing of the filing of the terminal disclaimer is not believed to impact the Examiner's burden or to retard the prosecution on the merits, especially given the expedience with which the terminal disclaimer can be filed.

Accordingly, Applicants respectfully request that their offer to file a terminal disclaimer when all other rejections and objections are negated be considered fully responsive to the current double-patenting rejection.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

Date: January 8, 2009

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